APPENDIX I.

In the United States Court of Appeals
For the Eighth Circuit.

No. 18,525, Civil.

Theodore C. Gerner, Plaintiff-Appellant,

v.

Moog Industries, Inc., Defendant-Appellee.

Appeal From the United States District Court for the Eastern District of Missouri, Eastern Division.

Petition by Plaintiff-Appellant for Rehearing.

This Court on September 19, 1967, handed down an Opinion which affirmed the District Court decree holding the Gerner patent No. 3,044,798 invalid. Plaintiff-appellant respectfully requests a rehearing because the factual conclusions accepted by this Court therein are clearly erroneous.

I. Summary.

The Court in its Opinion adopted as controlling on the issue of obviousness certain generalizing conclusions postulated by Defendant's expert and attributed to "the witnesses". These conclusions are inconsistent with the

testimony of Plaintiff's expert, have no foundation in engineering design analysis, and are *clearly erroneous* in the face of demonstrable evidence and the copying of Gerner's invention by Defendant.

II. Obviousness.

Initially, the Court's statement that the Moog "ball bearing structures did not lend themselves as well to one particular automobile, the Chevrolet" (Opinion p. 3), implies that the Gerner invention had limited applicability and impact on the automobile industry.[1] This is not the fact. The physical samples of the Moog idler arm in evidence (PX-4, physical; PX-5, physical; PX-6, physical) were only exemplary of an entire Moog line of accused idler arms (R. 26). In fact, at the time of the trial, Defendant had copied the Gerner invention in eighteen different applications, not just one. These eighteen applications are illustrated in the eighteen manufacturing drawings introduced at the trial (PX-8a through 8r).[2]

Presumably, this Court acknowledges as did the lower Court that the Gerner invention satisfies at least two of the requirements set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 525 (1966), i. e., utility and novelty. However, this Court concluded that Gerner's new combination was obvious to one of ordinary skill in the art at the time it was made (35 U. S. C. § 103).

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[1] The importance of the idler arm to the proper operation of an automobile is demonstrated by the recent recall by General Motors of 1,330,000 Chevrolets and Pontiacs. See Appendix, p. 5a.

[2] The colloquy at the trial between the District Court and the attorney for Plaintiff with respect to the eighteen drawings introduced as Exhibits 8a through 8r by Plaintiff was not printed in the original record but is included in the Appendix hereto (p. i). This colloquy would have appeared before the statement by the Court receiving Exhibits 1-8 (R. 64).

The Supreme Court in *Graham* acknowledged that difficulties would exist in applying the non-obviousness test, but likened the difficulties to those encountered "in such frames of reference as negligence and scienter" (at 15 L. Ed. 2d 556). However, whereas negligence and scienter invoked the standard of the reasonably prudent man in which category the esteemed judiciary clearly qualifies, the non-obviousness test for patent validity depends upon the state of mind of one skilled in a technical art. The judiciary ordinarily does not so qualify.

Accordingly, in patent litigation under our legal system, it is incumbent upon one unskilled in the art to determine whether or not the subject matter would have been obvious or unobvious to one skilled in the art. The only basis to make such a determination must of necessity be the testimony of the expert witnesses called upon by the parties to define the scope of the prior art, the advancement made thereover by the invention at issue and the character of such advancement. This is particularly so in the complex art of today's sophisticated automobiles.

Only two expert witnesses were called to testify at the trial in this case, Dean Fischer on behalf of Defendant and Homer Smith on behalf of Plaintiff. A careful scrutiny of their testimony reveals a basic divergence and, further, that if Dean Fischer did understand the Gerner invention at the time of trial, he certainly did not project this knowledge into his testimony.

The particular testimony of Professor Fischer in point was specifically noted by this Court:

> all of the structures called for in Gerner Claim 1 are found in the Ingersoll patent and also that the Swiss patent, structure for structure, absolutely responds to the Gerner patent (page 5).

This testimony is blatantly incorrect. It is inconsistent with the testimony of Homer Smith, Plaintiff's expert (R. 124-130, 134).

More specifically, Claim 1 defines as part of the claimed combination *wedging contact* of the wedge means (bearing) with both the "male member *and* the female member". Defendant reluctantly admitted in its Brief to this Court that it is Gerner's three-piece bearing "alone" which is capable of such *wedging contact* (D. Brief 8). By impeccable syllogistic reasoning, neither "all of the structures called for in Gerner Claim 1 are found in the Ingersoll patent" nor does "the Swiss patent, structure for structure, respond(s) to the Gerner patent", because Claim 1 and the Gerner patent require a three-piece bearing (major premise) and neither Ingersoll nor the Swiss patent discloses a three-piece bearing (or, for that matter, any bearing having the *wedging contact* achieved by Gerner's invention) (minor premise).

In view of this inaccuracy in the testimony of Dean Fischer, it seems apparent that he intentionally or unintentionally failed to comprehend the basic innovation of Gerner's invention. Failure of Defendant's expert to appreciate the invention at the time of trial should be overwhelming evidence of unobviousness.

Further in this regard is Fischer's testimony, also noted by this Court, that "if somebody wanted a joint that takes up wear, it would only be necessary to utilize the Swiss disclosure" (Opinion p. 6). However, the record is devoid of any shread of proof that the Swiss disclosure relied upon by Defendant was ever used, and *Defendant itself did not utilize the Swiss disclosure in designing its idler arm.*[3] *Rather, Defendant copied the Gerner design placed on the*

[3] As to the effect of an absence of commercial activity for the prior art, see *Ling-Temco-Vought, Inc. v. Kollman Instrument Corp.*, 372 F. 2d 263, 267 (2nd Cir. 1967), and cases cited therein.

market by Plaintiff's company. In particular, Defendant copied the Gerner three-piece bearing in order to obtain the wedging contact between both the male member and the female housing.

The significance in operation between a solid ring and a three-piece bearing was demonstrated to this Court at oral hearing by means of a simple demonstration. Specifically, a solid ring in the assembly in suit, i. e. an idler arm frame bracket end pivotal connection renders the structure *inoperative* because the ring will not remain rotationally fixed in the female housing due to the absence of the requisite *wedging contact.* The necessity of such non-rotational movement of the bearing in the female housing for an operative idler arm pivotal connection was also admitted by Defendant to this Court (D. Brief 17). On the other hand, Gerner's three-piece wedge means is capable of being rotationally fixed in the female housing while longitudinally moveable in the event of wear, shock or imprecision in manufacture.

The Court's reference to the colored drawings of Gerner, Swiss and Ingersoll (Opinion p. 5) is also revealing because these drawings, in fact, fail to illustrate the significant aspects of the structures illustrated. It is virtually impossible to distinguish the three-piece bearing from the ring bearing when illustrated in vertical cross-section. Therefore, it should have been apparent to this Court why the colored drawings are misleading.

Finally, this Court in its Opinion noted in connection with Gerner's three-section wedge means, "the difference (over the prior art) appears to be in configuration only because the prior art discloses upper and lower wedge means, which *according to the witnesses* perform the same function" (Opinion p. 6) (Emphasis added). To what witnesses the Court has reference is unclear. Certainly Dean Fischer did not so testify because he did not even

appreciate the difference between the three-section wedge means and the solid ring. On the other hand, Homer Smith testified unequivocally that the three-section wedge means did not perform the same function as the solid ring wedge means,

> Q. ——are we going to produce a structure which operates in the same fashion as the structure illustrated in the Gerner patent?
>
> A. No, you would not.
>
> Q. Now, can you explain why not?
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> A. Well, the structure in the Gerner patent specifically the wedge elements or wedge means which engage the tapered cone not only wedgingly engage the tapered cone or stud, but they also wedgingly engage or are in wedging contact with the internal surface of the bore. Now in the structure of Ingersoll, the rings, I believe they are numbered 8, colored in yellow are actually one piece solid rings and they will have wedging contact, of course, with the blue part which is equivalent to the tapered stud since we have made it rigid with stud 1, but this cannot expand. They could not have wedging contact with the internal surface of the female bore as in the Gerner structure.

Furthermore, this fact was graphically demonstrated to this Court at oral hearing.

Accordingly, the testimony at the trial by the witnesses was not to the effect that the three-section bearing and the solid ring bearing perform the same function, because in fact they cannot. The Gerner combination not only is novel, but also produces a new result by means of the bearing performing a new function.

In view of the above, it is submitted that the Court merely accepted the broad generalizations and conclusions postulated by Defendant through its expert without

analyzing the testimony or inquiring into the inherent inaccuracies it produced in the conclusions adopted by this Court. Inasmuch as there was a clear conflict between the testimony of Defendant's expert and that of Plaintiff's expert, it should be incumbent upon the Court to resolve the inconsistencies and determine which testimony is correct based upon an analysis and interpretation of the technical evidence available.

Such an analysis of the testimony can lead to only one conclusion. The testimony of Dean Fischer demonstrates a misunderstanding of the Gerner invention at the time of trial. *A greater testimonial to the unobviousness of Gerner's advancement in the art is hard to imagine.*

III. Post-Graham Decisions.

While admittedly statistics are ofttimes misleading and with all due respect to this Court, it is appalling that in the ten reported opinions[4] handed down by the Eighth Circuit since the 1966 decisions of the Supreme Court in the *Graham, Calmar* and *Adams* cases,[5] each and every

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[4] Kell-Dot Industries, Inc. v. Graves, 361 F. 2d 25, 149 U. S. P. Q. 717 (8th Cir. 1966), cert. denied 385 U. S. 842; *American Infra-Red Radiant Co. v. Lambert Industries, Inc.*, 360 F. 2d 977, 149 U. S. P. Q. 722 (8th Cir. 1966), cert. denied 385 U. S. 920; *Skee-Trainer, Inc. v. Garelick Mfg. Co.*, 361 F. 2d 895, 150 U. S. P. Q. 7 (8th Cir. 1966); *Piel Manufacturing Company v. George A. Rolfes Co.*, 363 F. 2d 57, 150 U. S. P. Q. 330 (8th Cir. 1966); *Automated Building Components v. Hydro-Air Engineering*, 362 F. 2d 989, 150 U. S. P. Q. 421 (8th Cir. 1966); *Superior Concrete Accessories v. Richmond Screw Anchor Co.*, 369 F. 2d 353, 151 U. S. P. Q. 677 (8th Cir. 1966); *Imperial Stone Cutters, Inc. v. Schwartz*, 370 F. 2d 425, 152 U. S. P. Q. 91 (8th Cir. 1966), cert. denied 386 U. S. 977; *L & A Products, Inc. v. Britt Tech Corporation*, 365 F. 2d 83, 150 U. S. P. Q. 770 (8th Cir. 1966); *Greening Nursery Co. v. J & R Tool & Mfg. Co.*, 376 F. 2d 738, 153 U. S. P. Q. 660 (8th Cir. 1967); *General Mills, Inc. v. Pillsbury Co.*, ... F. 2d ..., 154 U. S. P. Q. 207 (8th Cir. 1967).

[5] *Graham v. John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 545 (1966); *United States v. Adams*, 383 U. S. 39, 15 L. Ed. 2d 572 (1966).

patent has been held invalid, invariably on the basis of Section 103. It seems incredible that the Patent Office, as the Government agency possessing the skill in the art and the legislative responsibility to determine obviousness and unobviousness, could have failed in issuing all of the patents considered by the Eighth Circuit in the last nineteen months.

Furthermore, an analysis of the post-Graham decisions from the neighboring Seventh Circuit dealing with patent validity which have been reported to date in the United States Patent Quarterly[6] reveals that almost 50 percent of those patents adjudicated on the question of invention were upheld as valid. Is it possible that the standard of patentability required in the Eighth Circuit is out of step?

IV. Conclusion.

The Supreme Court decision in the *Graham* case relegated secondary considerations to a rather minor role in determining the question of unobviousness. These are not the basic inquiries on the question of obviousness. This was most forcefully brought out in the reversal of the *Calmar* decision originating in this Circuit.

The determination must hinge primarily on the expert testimony adduced. The testimony in this case directed to the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art, demonstrate a clear basis on which to determine that the issuance of the Gerner patent by the Patent Office was proper and that Defendant's attack on validity should not be sustained.

Accordingly, Plaintiff-Appellant respectfully requests a rehearing directed specifically to the testimony of De-

[6] See Appendix, pp. 1a-3a.

fendant's expert insofar as it conflicts with the testimony of Plaintiff's expert and demonstrable evidence.

Respectfully submitted,

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